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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/528,458 Confirmation No.: 4928
Applicant(s): Chen et al.
Filed: 10/06/2005
Art Unit: 2876
Examiner: St. Cyr, Daniel
Title: Anti-Misinsertion Mechanism Of Card Connector

Attorney Docket No.: 003D.0056.U1(US)
Customer No.: 87,120

Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Petition To Commission
(37 C.F.R. §1.181)

Sir:

This is a petition under 37 C.F.R. §1.181 to invoke the supervisory authority of the Commissioner.

Statement Of Facts

1. In an Ex Parte Quayle office action mailed 07/20/2009, the examiner objected to claims 10, 18 and 19 stating:

"Claim 10 seems to be in independent form, but relying on limitations of claim 1 and claims 18 and 19 on limitations of claim 11. If these claims are independent all limitations must be written or write them in proper dependent form."

2. In a Response To Office Action filed 10/15/2009, Applicants' Attorney requested the examiner to reconsider his objection.

3. On 03/08/2010 (almost 5 months later) the examiner issued:

- a. An Advisory Action indicating that the format of claim 10 is acceptable, but claims 18 and 19 remain objected to; and
- b. A Notice of Non-Compliant Amendment.

Point To Be Reviewed

1. Is the examiner's objection to claims 18 and 19 correct?
2. Was the examiner's action in issuing an Advisory Action rather than a new office action making the objection "final" correct?
3. Was the examiner's action of issuing a Notice of Non-Compliant Amendment correct?

Action Requested

1. The Commissioner is requested to reverse the examiner's objection to claims 18 and 19. In the alternative, the Commission is requested to have the examiner issue a new office action indicating that the objection is made "final".
2. The Commissioner is requested to withdraw the Notice of Non-Compliant Amendment

Discussion

Claims 18 and 19 have been objected to by the examiner because the examiner believes that claims 18 and 19 seem to be in independent form, but rely on limitations of claim 11.

The Commissioner's attention is drawn to MPEP 2173.05(f) "Reference to Limitations in Another Claim" which states:

"A claim which makes reference to a preceding claim to define a limitation is an acceptable claim construction which should not necessarily be rejected as improper or confusing under 35 U.S.C. 112, second paragraph. For example, claims which read: "The product produced by the method of claim 1." or "A method of producing ethanol comprising contacting amylose with the culture of claim 1 under the following conditions" are not indefinite under 35 U.S.C. 112, second paragraph, merely because of the reference to another claim. See also *Ex parte Porter*, 25 USPQ2d 1144 (Bd. Pat. App. & Inter. 1992) where reference to "the nozzle of claim 7" in a method claim was held to comply with 35 U.S.C. 112, second paragraph. However, where the format of making reference to limitations recited in another claim results in confusion, then a rejection would be proper under 35 U.S.C. 112, second paragraph.

In the Response To Office Action filed 10/15/2009, Applicants' Attorney explicitly stated "In regard to claim 18, claim 18 is a dependent claim." Claim 18 recites:

18. A card connector comprising:

a frame forming a card receiving slot; and

the anti-misinsertion mechanism of Claim 11 connected to the frame

In this case, the format used to make reference to claim 11 is not confusing; at least no more confusing than the examples given in the MPEP 2173.05(f) of:

- "The product produced by the method of claim 1." or
- "A method of producing ethanol comprising contacting amylose with the culture of claim 1 under the following conditions"

In the Response To Office Action filed 10/15/2009, Applicants' Attorney explicitly stated "In regard to claim 19, claim 19 is a dependent claim." Claim 19 recites:

19. A card connector comprising the anti-misinsertion mechanism of claim 11 ...

In this case, the format used to make reference to claim 11 is not confusing; at least no more confusing than the examples given in the MPEP of:

- "The product produced by the method of claim 1." or
- "A method of producing ethanol comprising contacting amylose with the culture of claim 1 under the following conditions"

This is the same type of format used in claim 10 which the examiner indicated as being an acceptable form. The examiner's reason for allowing claim 10 but not allowing claims 18-19 is indistinguishable.

Claims 18 and 19 are in allowable dependent form and should be allowed.

In the event the Commissioner believes that claims 18-19 are not in an allowable dependent form, then the Commissioner should direct the examiner to issue a new office action indicating that the objection is being made "final". The Ex Parte Quayle office action mailed 07/20/2009 was the first time the examiner objected to claims 18-19. Making the office action mailed 07/20/2009 final was premature. A petition, such as this Petition, to have the objection to claims 18-19 reviewed would have been premature until the examiner repeated his objection to claims 18-19 a second time or until he made the objection "final". Applicants' Attorney could not file this petition any earlier because USPTO rules require that a Petition regarding an

objection wait until the objection has been made "final" or has been made a second time. The examiner, in this case, only made the objection to claims 18-19 a single time; in the office action mailed 07/20/2009. The Commissioner is directed for example to 37 C.F.R. 1.181(c) which indicates that "When a petition is taken from an action or requirement of an examiner ..., it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner." (emphasis added) Issuing an Advisory Action in reply to the Response To Office Action filed 10/15/2009, rather than a new office action making the objection "final" was, thus, inappropriate.

In regard to the Notice of Non-Compliant Amendment, it was inappropriate for the examiner to issue such a Notice. The Response To Office Action filed 10/15/2009 contained no Amendment. The Response merely asked the examiner to reconsider his objection to claims 10, 18 and 19. Thus, the Response filed 10/15/2009 was fully responsive to the office action mailed 07/20/2009. It was inappropriate for the USPTO to issue a Notice of Non-Compliant Amendment. Furthermore, MPEP 714.13 also states:

"An examiner is expected to turn in a response to an amendment after final rejection within 10 calendar days from the time the amendment is received by the examiner. A reply to an amendment after final rejection should be mailed within 30 days of the date the amendment is received by the Office." and "Prompt notice to applicant is important because it may avoid an unnecessary appeal and act as a safeguard against a holding of abandonment. Every effort should be made to mail the letter before the period for reply expires.

The examiner waited almost 5 months after the Response was filed on 10/15/2009 to issue an Advisory Action. This was not

appropriate.

Summary

The Commissioner is requested to direct that the objection to claims 18-19 be withdrawn, or to have the examiner issue a new office action making the objection "final".

Respectfully submitted,

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3/12/10
Date

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